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09/402,702	10/06/1999	DOMINIQUE CAZIN	511/96506.01	6300

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EXAMINER

POKRZYWA, JOSEPH R

ART UNIT

PAPER NUMBER

2622

DATE MAILED: 07/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/402,702	<b>Applicant(s)</b> CAZIN, DOMINIQUE	
	<b>Examiner</b> Joseph R. Pokrzywa	<b>Art Unit</b> 2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 02 December 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Arguments filed in the Appeal Brief*

1. Applicant's arguments filed in the Appeal Brief dated 12/2/04, with respect to the rejection of claim(s) 1 and 3-7, as cited in the final Office action dated 8/26/03 under 35 U.S.C. 102(e) as being anticipated by Rachelson (U.S. Patent Number 6,157,706), have been fully considered and are persuasive. Therefore, the finality of that Office action is hereby withdrawn. The examiner further notes that applicant's amendment that was filed after final, being dated 12/29/03, has been entered, therein having claims 1 and 3-7 as pending.
2. Upon further consideration and search by the examiner, prosecution on the merits of this application is reopened on claims 1 and 3-7, as a new ground(s) of rejection is made in view of Suzuki (U.S. Patent Number 6,005,677) and Sakagawa (U.S. Patent Number 5,774,662).

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. **Claims 1 and 3-5** are rejected under 35 U.S.C. 102(e) as being anticipated by Suzuki (U.S. Patent Number 6,005,677).

Regarding *claim 1*, Suzuki discloses a fax machine (see Figs. 1 and 2) designed to be connected to a telephone network and to communicate with a corresponding fax machines across a computer network of the Internet type (see Fig. 1), the fax machines each having an electronic address on the aforesaid computer network (see Fig. 3), characterized by the fact that it has memory means for storing a record of the fax machine communications with corresponding fax machines (parameter memory 3, see Fig. 2), containing the electronic addresses of the aforesaid corresponding fax machines (see Fig. 3, column 3, line 66-column 4, line 13), means for managing the record, for extracting the electronic addresses and associating them with the corresponding fax machines (system controller 1, see Fig. 2, column 3, lines 10-22, column 4, lines 7-45, and column 5, lines 4-13) and means for asking a corresponding fax machine for its electronic address, during a communication with the aforesaid corresponding fax machine across the telephone network (column 4, line 57-column 5, line 13, being the calling signal at step 112 and the predetermined pre-transmission procedure process step 113), the aforesaid means for managing the record being adapted for entering the aforesaid electronic address of the corresponding fax machine into the record (steps 114 and 115, column 5, lines 4-13), and in which means being provided to receive a fax transmitted from a corresponding fax machine across the aforesaid computer network and associated with the electronic address on the computer network of the corresponding fax machine (see Fig. 11, column 3, line 43-column 4, line 45, and column 8, line 65-column 9, line 45), the means for managing the record are organized, upon the receipt of the fax, to enter the electronic address of the aforesaid corresponding fax machine into the record (see Figs. 9-11, and column 8, line 27-column 9, line 45).

Regarding *claim 3*, Suzuki discloses the fax machine discussed above in claim 1, and further teaches of means being provided to send to a corresponding fax machine, via the computer network, a fax associated with the electronic address on the computer network of the corresponding fax machine (column 4, lines 14-45), the means for managing the record are adapted to enter the electronic address of the aforesaid corresponding fax machine into the record prior to sending the fax (column 4, line 57-column 5, line 13, whereby the electronic address is entered into the conversion table in a previous communication).

Regarding *claim 4*, Suzuki discloses the fax machine discussed above in claim 1, and further teaches that since each electronic address contains identification data (column 4, lines 7-13), the means for managing the record are organized to extract the aforesaid identification data from each address of a corresponding fax machine and to associate the data with aforesaid address in the record (column 4, lines 26-45).

Regarding *claim 5*, Suzuki discloses the fax machine discussed above in claim 4, and further teaches that the means for managing the record are organized to compare the identification data extracted from each new electronic address relating to a corresponding fax machine with the identification data associated with the electronic addresses stored in the record in order to check whether the aforesaid identification data is already associated with the electronic address in the record (column 4, lines 26-45).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 6 and 7** are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki (U.S. Patent Number 6,005,677) in view of Sakagawa (U.S. Patent Number 5,774,662).

Regarding **claim 6**, Suzuki discloses the fax machine discussed above in claim 5, but fails to expressly disclose if when the identification data extracted from the new electronic address is already associated with an electronic address in the record, the means for managing the record are organized to compare the electronic address held in the record with the new electronic address and, where they are not identical, to replace the former with the latter in the record.

Sakagawa discloses a system that stores electronic addresses in an address table obtained through an electronic communication data exchange (see abstract, and column 7, lines 21-35). Further, Sakagawa teaches that where identification data extracted from a new electronic address is already associated with an electronic address in the record, a means for managing the record are organized to compare the electronic address held in the record with the new electronic address and, where they are not identical, to replace the former with the latter in the record (column 7, lines 21-49).

Suzuki & Sakagawa are combinable because they are from similar problem solving areas, being systems that store electronic addresses in an address table. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to include the address table

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management teachings of Sakagawa in the system of Suzuki. The suggestion/motivation for doing so would have been that a large capacity address table would be unnecessary, therein minimizing the amount of hardware, as recognized by Sakagawa in column 7, lines 42-49. Therefore, it would have been obvious to combine the teachings of Sakagawa with the system of Suzuki to obtain the invention as specified in claim 6.

Regarding *claim* 7, Suzuki discloses the fax machine discussed above in claim 1, but fails to expressly disclose that since the memory means have a limited storage capacity, when the aforesaid memory means are full, the means for managing the record are organized to erase the oldest electronic address in the memory means prior to entering a new electronic address.

Sakagawa discloses a system that stores electronic addresses in an address table obtained through an electronic communication data exchange (see abstract, and column 7, lines 21-35). Further, Sakagawa teaches that a memory means has a limited storage capacity, when the aforesaid memory means are full, the means for managing the record are organized to erase the oldest electronic address in the memory means prior to entering a new electronic address (column 7, lines 21-49).

Suzuki & Sakagawa are combinable because they are from similar problem solving areas, being systems that store electronic addresses in an address table. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to include the address table management teachings of Sakagawa in the system of Suzuki. The suggestion/motivation for doing so would have been that a large capacity address table would be unnecessary, therein minimizing the amount of hardware, as recognized by Sakagawa in column 7, lines 42-49.

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Therefore, it would have been obvious to combine the teachings of Sakagawa with the system of Suzuki to obtain the invention as specified in claim 7.

***Citation of Pertinent Prior Art***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

**Ishibashi *et al.*** (U.S. Patent Number 6,374,291) discloses a communication terminal device; and

**Okada *et al.*** (U.S. Patent Number 6,088,125) discloses a facsimile machine having a memory that stores electronic addresses.

***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe Pokrzywa whose telephone number is (571) 272-7410. The examiner can normally be reached on Monday-Friday, 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (571) 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

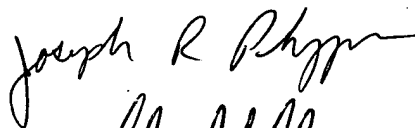


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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

jrj

Joseph R. Pokrzywa  
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